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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/668,255	09/21/2000	Michael H. Evelyn	2955/103	1374
2101 7590 02/08/2007 BROMBERG & SUNSTEIN LLP 125 SUMMER STREET BOSTON, MA 02110-1618			EXAMINER GREENE, DANIEL LAWSON	
			ART UNIT 3694	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	DELIVERY MODE
3 MONTHS			02/08/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/668,255

Applicant(s)

EVELYN ET AL.

Examiner

Daniel L. Greene Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-74 is/are pending in the application.
- 4a) Of the above claim(s) 20-33 and 63-74 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 and 34-62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-74 are pending. Claims 20-33 and 63-74 are withdrawn as being drawn to a non-elected invention. Claims 1-19 and 34-62 have been examined herein on their merits.

Specification

2. The disclosure is objected to because of the following informalities:
- a. Page 16 line 22, change the word "if" to "of"
 - b. Page 22 line 7, change the word "An" to "A"
 - c. Page 23 line 1 remove the word "the" before the word "whatever"

Appropriate correction is required.

Claim Objections

3. Claims 35 and 36 are objected to because of the following informalities:
- a. Claim 35 was amended to depend from claim 34. Claim 35 is objected to since it refers back to claim 34 as a "method" when claim 34 is directed towards a "computer program product". Applicant's amendment to the claim necessitated this objection.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

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art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. **Regarding the 112 rejection from section 4 of the previous Office action mailed 10/18/2005, Applicant's arguments received 10/16/2006 have been fully considered but are not persuasive.** It is not seen wherein the addition of a comma and the limitation "the competitive bid having" is considered adequate in setting particularly pointing out and distinctly claiming subject matter which applicant regards as the invention.

Although the claims are read in light of the specification, limitations from the specification are NOT read into the claims. Therefore, the claims must stand alone and convey in an explicitly distinct and exact fashion what applicant considers to be the invention.

For Example, Applicant's claims set forth "a private price that is not visible to auction participants other than at most a bidder who submitted the competitive bid..." It is unclear exactly what this limitation is attempting to claim. This appears to set forth some ubiquitous number, for example in someone's head that might be the real amount an individual wishes to pay but is not willing to communicate. It appears applicant may be attempting to claim something that is unpatentable, i.e. a human thought process, that is, a private, personal and

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undisclosed maximum amount that a buyer is willing to pay without actually expressing to anyone what that amount is.

Further, no meaning can be gleaned from the claims as to how and in what manner the "protected range is associated with the online auction;" According to the specification page 23, lines 21-24, it appears the "protected range" is set by the issuer's criteria of the auction and as such is not properly associated with the online auction as much as being associated with the issuer's preferences. The limitation "is associated with the online auction" does not connote any particular method or structure, per se, and as such is vague and indefinite as it is unclear exactly how and in what manner the protected range is associated. Again, one would not be able to determine exactly when they would or would not infringe upon any potential protection afforded to the instant invention.

The wherein clause contained within the claim provides for limitations that are optional but not required. Indeed, the limitations that follow said limitation are speculative by nature in and of themselves, that is, applicant is requested to specifically and explicitly explain how and in what manner a person skilled in the art would be able to determine the likelihood of how and in what manner an auction is going to behave or be awarded. Again, the limitation "wherein the private price represents a price that has an equal or greater likelihood of the competitive bid being allocated securities than the likelihood of the competitive

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bid being allocated securities based on the public price" can be given no definite and explicit meaning or manner of determination.

In response to this rejection, Applicant is respectfully requested to set forth where, in the specification as filed, support may be found for each and every limitation set forth in claims 1, 15 and 34, including page and line number. This requirement is to ensure a clear and unambiguous understanding of exactly what Applicant is attempting to set forth as the invention.

7. Claims 36 and 36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 35 was amended to depend from claim 34. As explained above, claim 34 is directed towards a computer program product. Since claim 34 fails to set forth "a method" per se, claims 35 and 36 are accordingly vague and indefinite in failing to set forth exactly what it is they are attempting to modify. Again, this rejection was necessitated by applicant's amendment to the claims.

8. Claims 1-19 and 34-62 are rejected under 35 U.S.C 103(a) as being unpatentable over (US 6,058,379) Odom in view of (US 6,629,082) Hambrecht for the reasons set forth in section 6 of the previous Office action mailed 10/18/2005

Applicant's arguments regarding the limitation " a public price that is visible to all auction participants and a private price that is not visible to auction participants" have been fully considered but are not persuasive. Indeed, it can be considered that ALL auctions inherently have a public price that the auction participants make visible to all participants as that is considered their actual bid, while the private price is considered the maximum amount a participant would be willing to bid during the auction period. Applicants limitation "the private price represents a price that has an equal or greater likelihood of the competitive bid being allocated securities that the likelihood of the competitive bid being allocated securities based on the public price" is considered as supporting the Examiners contention that such is so as Oden sets forth "Both buyer and seller will use the bidding mechanism to raise and lower bids and offers...This will allow electronic price negotiation between buyers and sellers...". This statement is considered as setting forth both a public price, i.e. that which the buyer would like to pay, in contrast to and including the private price, i.e. that which the buyer would ultimately have to pay in order to secure the negotiation.

Further, it is not seen wherein the claims set forth the specific requirement that the private price be entered or received by the system. That is, the claim

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language only provides that the competitive bid has a private price, not that said private price is entered into the bid mechanism.

Further, it is considered that the limitation "private price" can be considered as the maximum bid amount a buyer would pay. That is, resort may be had to, for example, E-bay, where one can enter the maximum amount one is willing to pay for an item. Although the price may start at \$1 the buyer may be willing to spend \$20 maximum. This maximum number is not shown to any of the other buyers and the other buyers would not know what this number is until they themselves bid higher than said maximum limit.

It can also be considered that applicant is merely automating a process that was previously performed by hand. That is, in the background of the invention applicant sets forth that these processes were already being performed by for example, people and paper and telephones. Resort may be had to case law in support that the mere automation of a process does not imply patentability unless some new and unusual effect is produced. A review of applicant's invention reveals nothing more than the automation of a process previously performed manually. See, for example, MPEP 2144.04[R-1]. III and In re Venner, 120 USPQ 192 (CCPA 1958) and In re Rundell, 9 USPQ 220, "It is not 'invention' to broadly provide a mechanical or automatic means to replace manual activity which has accomplished the same result"

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9. Examiner's Note: The Examiner has cited particular columns and line numbers in the references as applied to the claims for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

11. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel L. Greene Jr. whose telephone number is (571) 272-6876. The examiner can normally be reached on Mon-Fri 8:30am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DIG

2007-02-01


ELLA COLBERT
PRIMARY EXAMINER